UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Folk II, Robert H.	GROUP ART UNIT:	2134
APPLN. NO.:	10/690,053	EXAMINER:	Powers, William S.
FILED:	Oct. 21, 2003	Confirmation No.:	3498
TITLE:	APPARATUS AND METHOD FOR PROVIDING A VIRTUAL COMMON HARD DISK RECORDER RESOURCE		

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Final Office Action mailed from the U.S. Patent and Trademark Office on July 31, 2008, Applicant requests review of the final rejection in the above-identified application. This request is being filed with a Notice of Appeal and required fee. The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 50-2117.

No amendments are being filed with this request. The review is requested for the reasons stated in the remarks below.

STATUS OF CLAIMS

Claims 1-3 and 10-12 are pending in this application.

In the final Office Action dated July 31, 2008, claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese et al. (US 2002/0141732, hereinafter "Reese") in view of Barton et al. (US 2003/0095791, hereinafter "Barton"). Claims 10-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reese in view of Barton and further in view of Asano et al. (US 2003/0051151, hereinafter "Asano").

REMARKS

The rejections of claims 1-3 and 10-12 under 35 U.S.C. § 103(a) are respectfully traversed.

Independent claim 1, as amended, requires, *inter alia*, "determining whether the requested content resides in an encrypted form on the first hard disk recorder, wherein the encrypted form comprises encryption via a local encryption scheme" and "if the requested content does not reside on the first hard disk recorder, determining whether the requested content resides in the encrypted form on a second hard disk recorder".

Applicant submits that neither Reese nor Barton discloses at least the aforementioned features of independent claim 1. In particular, it is submitted that secondary citation to Barton does not remedy deficiencies in the primary citation to Reese. Accordingly, without conceding the propriety of the asserted combination, the asserted combination of Reese and Barton is likewise deficient, even in view of the knowledge of one of ordinary skill in the art.

The Examiner states that "Reese decodes video content . . . , but does not expressly mention the encryption schemes." (Office Action, p. 5.) Applicant agrees with the Examiner that the claimed limitations are missing from Reese. To the extent that the Examiner contends that the missing limitations can be found in Barton, this contention is respectfully traversed.

Reese is directed to "adapting each DVR to control, via an Ethernet network, all the other video recording devices (DVRs) on the network" (Reese, para. 0011), where each digital video recorder-controller (DVRC) receives video signals from video cameras (FIGs. 1 and 2, para. 0015). The final Office Action, at page 5, contends that Reese

teaches "determining whether the requested content resides . . . on a second hard disk recorder," citing paragraphs 0020 and 0023 for this feature. Applicant respectfully traverses the Office Action's strained characterization of Reese, which contends that Reese discloses that a master DVRC "can issue a control signal to itself . . . and display the selected video image whether it resides on the master DVRC or from other DVRs or DVRCs in the network." (Office Action, p. 5.) No discussion of such features appears in paragraphs 0020 and 0023 of Reese, or elsewhere in Reese. Reese fails to teach "determining whether the requested content resides . . . on a second hard disk recorder," as recited in claim 1.

The Examiner notes, and the Applicant concedes, that paragraph 0085 of Barton "teaches storing encrypted content on a hard disk" (Office Action, p. 5). Applicant acknowledges that Barton states that "the media content is decrypted only if it is viewed, thus protecting the content from theft. It is possible for the DVR to save these encrypted media streams to disk, and initiate decryption upon playback" (para. 0085).

However, Applicant respectfully submits that Reese and Barton, including the cited passage from Barton, fail to teach the presently claimed features of "determining whether the requested content resides in an encrypted form on the first hard disk recorder, wherein the encrypted form comprises encryption via a local encryption scheme" and "if the requested content does not reside on the first hard disk recorder, determining whether the requested content resides in the encrypted form on a second hard disk recorder".

Barton discloses transferring media and database elements between two DVRs where one of the DVRs is a portable DVR. (Barton, para. 0076.) Barton teaches a method "to encrypt the data transfer between the DVRs." (Barton, para. 0079.) Barton also discloses, at paragraph 0085, that an encrypted media stream may be saved to disk on a first DVR, and may be transferred between two DVRs. However, neither Barton nor Reese teaches "determining whether the requested content resides in the encrypted form on a second hard disk recorder." Thus, Barton does not provide a disclosure that remedies the deficiencies in the primary citation to Reese.

Since Barton fails to supply features missing from Reese, the combination of Reese and Barton cannot suggest the invention and cannot render the claims obvious. Thus, no matter how Reese and Barton may be combined (even assuming, arguendo, that

one of ordinary skill in the art would be led to combine them) the resulting combination is not the invention recited in claim 1.

It is further submitted that Barton *teaches away* from "determining whether the requested content resides in the encrypted form on a second hard disk recorder," and "displaying the requested content on a display device coupled to the first hard disk recorder," as required by claim 1. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)) The path taught by Barton is "to encrypt the data transfer between the DVRs" (para. 0079) and "to encrypt the data during the transfer" (para. 0080). Barton also discloses that an encrypted data stream may be transferred between two DVRs if it has previously been stored on the **first** DVR as an encrypted media stream (para. 0085). Barton then teaches displaying the content at the **destination** DVR, not the first DVR (see para. 0087). Thus, a person of ordinary skill, upon reading Barton, would be led in a direction divergent from the path that was taken by the Applicant.

Applicant respectfully submits that Barton fails to provide a basis for a rejection under 35 U.S.C. § 103, at least because Barton *teaches away* from determining whether the requested content already resides in an encrypted form on the second hard disk recorder, and viewing it on a display device coupled to the first hard disk recorder, as recited in claim 1. Because Barton is an improper basis for rejecting Applicant's claims, the combination of Barton with Reese, or with other prior art references, is also an improper basis for rejecting Applicant's claims.

Claims 2-3 and 10-12 are dependent upon claim 1. Because claims 2-3 and 10-12 depend from an allowable base claim, the cited combination of Reese and Barton, or of Reese and Barton further in view of Asano, cannot render claims 2-3 and 10-12 obvious. Therefore, Applicant submits that claims 2-3 and 10-12 are patentable over the cited art, and requests that the rejection be withdrawn. Reconsideration of the rejections under 35 U.S.C. § 103 is respectfully requested.

In view of the foregoing discussion, it is believed that claims 1-3 and 10-12 are allowable over the cited art. Claims not specifically mentioned above are allowable due to their dependence on an allowable base claim.

In light of the arguments presented above, it is respectfully submitted that all pending claims are in condition for allowance. Reconsideration and withdrawal of the final rejection of the claimed invention is respectfully requested.

Respectfully submitted,
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